

05-29-01

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Patent
Attorney Docket: 265/018

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 265/018
First Named Inventor: Carrino
Prior Application Information:
Serial No. 09/290,577
Art Unit: 1655Assistant Commissioner for Patents
Box Patent Application
Washington, D. C. 20231

FILING UNDER 37 CFR § 1.53(b)

This is a request for filing for a

☐ continuation ☒ divisional ☐ continuation-in-part (CIP)application under 37 CFR § 1.53(b) of pending prior application Serial No. 09/290,577 filed on April 12, 1999, which will issue as U.S. Patent No. 6,238,868 on May 29, 2001, by**John J. CARRINO; Louis O. GERRUE; and Jonathan M. DIVER**, entitled:**MULTIPLEX AMPLIFICATION AND SEPARATION OF NUCLEIC ACID
SEQUENCES USING LIGATION-DEPENDANT STRAND DISPLACEMENT
AMPLIFICATION AND BIOELECTRONIC CHIP TECHNOLOGY**

For CONTINUATION or DIVISION APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied, referenced above, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

I. APPLICATION ELEMENTS ENCLOSED

80 Page(s) of Written Description
7 Page(s) of Claims
1 Page(s) of Abstract
34 Sheet(s) of Drawings ☒ formal ☐ informal
2 Page(s) of ☒ Declaration or ☐ Declaration and Power of Attorney
☒ Copy from prior application [37 CFR §1.63(d)]
☐ Newly executed

 Other:

OC-82799.1

CERTIFICATE OF MAILING
(37 C.F.R. §1.10)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as 'Express Mail Post Office To Addressee' in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

EL476728421US
Express Mail Label No.May 25, 2001
Date of DepositDenise Doss
Name of Person Mailing Paper
Denise Doss
Signature of Person Mailing Paper

- ☒ Assignment papers (cover sheet and documents(s))
- ☒ An Information Disclosure Statement, PTO 1449, ☐ with copies of cited items.
- ☐ Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i). Applicant must attach form PTO/SB/35

II. FEE CALCULATION

- ☐ Applicant claims small entity status under 37 CFR 1.27.

BASIC FILING FEE:						\$710.00
Total Claims	167	-	20	=	147	x \$18.00 \$2646.00
Independent Claims	2	-	3	=	0	x \$80.00 \$0.00
Multiple Dependent Claims	\$270	(if applicable)				<input type="checkbox"/> \$0.00
TOTAL OF ABOVE CALCULATIONS						\$3356.00
Reduction by ½ for Filing by Small Entity.						<input type="checkbox"/> \$0.00
Misc. Filing Fees (Recordation of Assignment)						\$0.00
TOTAL FEES DUE HERewith						\$3356.00

III. PRIORITY - 35 USC § 119

- ☐ Priority of application Serial No. _____ filed on _____ in Country is claimed under 35 USC § 119.
- ☐ The certified copy has been filed in prior U.S. application Serial No. _____ on _____.
- ☐ The certified copy will follow.

IV. AMENDMENTS

- ☐ Cancel in this application original Claims _____ of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes if no new claims are added in a preliminary amendment.)
- ☒ A Preliminary Amendment is enclosed. (Claims added by Amendment must be numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

V. RELATE BACK - 35 USC § 120

- ☐ Relate back information included in preliminary amendment or specification.
- ☐ Please amend the specification as follows: after the title, insert:
- This application is a divisional of USSN 09/290,577, filed April 12, 1999,
now U.S. Patent No. 6,238,868.--
- ☒ With respect to the prior co-pending U.S. application from which this application
claims benefit under 35 USC § 120, the inventor(s) in this application is (are)
[37 CFR 1.53(b)(1)]:
- ☒ the same.
- ☐ less than those named in the prior application and it is requested that the
following inventor(s) identified above for the prior application be deleted [see
37 CFR §§1.33(b) AND 1.63(d)(2)]:
- [Name(s) of inventor(s) to be deleted]

VI. METHOD OF PAYMENT OF FEES

- ☐ Attached is a check in the amount of ____.
- ☒ Charge Lyon & Lyon's Deposit Account No. **12-2475** in the amount of **\$3356.00**
- ☐ Not attached. No filing fee is submitted. [This and the surcharge required by 37 CFR
§ 1.16(e) can be paid subsequently.]

VII. AUTHORIZATION TO CHARGE ADDITIONAL FEES

The Commissioner is hereby authorized to credit Lyon & Lyon's Deposit Account
No. **12-2475** for any over payment of fees and to charge the following additional fees by this
paper and during the entire pendency of this application to Deposit Account No. **12-2475**:

- ☒ 37 CFR § 1.16 (Filing fees and excess claims fees)
- ☒ 37 CFR § 1.17 (Application processing fees)
- ☒ 37 CFR § 1.21 (Assignment recordation fees)

VIII. POWER OF ATTORNEY & CORRESPONDENCE ADDRESS

- ☒ The power appears in the original papers in the prior application.
- ☐ The power does not appear in the original papers, but was filed on ____ in prior
application Serial No. ____.
- ☐ A new power has been executed and is attached.

Please send all correspondence to Customer Number 22249:



LYON & LYON LLP
Suite 4700
633 W. Fifth Street
Los Angeles, CA 90071
(213) 489-1600

Please direct all inquiries to Patrick S. Eagleman or David B. Murphy at the above Customer Number.

IX. MAINTENANCE OF CO-PENDENCY OF PRIOR APPLICATION

- ☐ A petition, fee and response has been filed to extend the term in the pending **prior** application until _____. A copy of the petition for extension of time in the **prior** application is attached.
- ☐ A conditional petition for extension of time is being filed in the pending **prior** application. A copy of the conditional petition for extension of time in the **prior** application is attached.

X. ABANDONMENT OF PRIOR APPLICATION

- ☐ Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application co-pending with said prior application. At the same time, please add the words "now abandoned" to the amendment of the specification set forth in Item V above.

Respectfully submitted,

LYON & LYON LLP

Dated: May 25, 2001

By: _____

Patrick S. Eagleman
Reg. No. 44,665

Enclosures

NANOGEN, INC./BECTON DICKINSON PARTNERSHIP

Name of Assignee

10398 Pacific Center Drive, San Diego, CA 92121

Address of Assignee

Vice President, Assistant General Counsel, and Assistant Secretary

Title of person authorized to sign on behalf of assignee

Assignment recorded in PTO on 04/12/99, Reel 9908, Frame 0773